

REMARKS

The non-final Office Action of April 21, 2011, (“the Office Action”) has been carefully reviewed and the remarks that follow are responsive thereto. Claims 1, 6, 7, 9-11, 14-16, 29, and 30 have been amended. No claims have been canceled. Claims 4, 5, 12, 13, and 17-26 were previously canceled. No claims have been added. No new matter has been introduced. Claims 1-3, 6-11, 14-16, and 27-30 thus remain pending. Reconsideration and allowance of the instant application are respectfully requested.

Claim Rejections Under 35 U.S.C. § 101

Claims 9-11, 14-16, 29, and 30 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Without acquiescing to the rejection, and in order to expedite prosecution, Applicant has amended claims 9-11, 14-16, 29, and 30 to be in more preferred form. Applicant respectfully submits that, as amended, claims 9-11, 14-16, 29, and 30 are directed to statutory subject matter. Thus, Applicant respectfully requests that this rejection be withdrawn.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-3, 6-11, 14-16, and 27-30 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. For the reasons set forth below, Applicant respectfully traverses this rejection.

The Office Action asserts:

Independent claims 1 and 9 have been amended to recite, “indicating on the first web phone, based on the displayed electronic program guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide.” No support is found in the specification of the instant application for these claim limitations (or in the provisional applications).

Applicant notes that support for the claimed limitations are found in application 09/488,361 now Patent No. 6,421,067. The Examiner has found the section entitled “Help Mode” at Column 11, Line 25 through Column 12, Line 13. While this portion of the ‘067 Patent discloses an EPG that indicates which buttons a remote control device are appropriate for performing functions for the EPG, the ‘067 Patent fails to teach that a first web phone is used as a

remote control device. The Examiner further notes that the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG. Therefore the '067 Patent fails to provide support for the claims.

Referring to claims 6-7 and 14-15, the specification fails to teach communication between multiple web phones.

Office Action at 4-5 (emphasis added). Despite the assertions of the Office Action, however, and as Applicant previously noted in the Amendment filed July 7, 2010, the pending claims of the instant application satisfy the written description requirement when considered in view of the Specification.

For instance, the Specification states:

As shown in FIG. 1, it is possible for several people to watch programming on video display 105 while one or more other persons uses computing device 150 to view an EPG on display screen 158. As a result, the programming displayed on video display 105 is undisturbed, and those perusing an EPG using computing device 150 can do so at their leisure. Also, because the EPG is shown on computing device 150, it is more easily customized and can be seen more clearly.

Specification at paragraph [0029] (emphasis added). Thus, the Specification describes displaying an electronic programming guide on a computing device. In addition, the Specification states:

Computing device 150 comprises a computer 156, a display screen 158, an input device 160, and connections 162a and 162b. Computer 156 may be any device, such as a Personal Computer (PC), a Personal Digital Assistant (PDA), or a web phone, capable of processing commands necessary to display output on display screen 158. Display screen 158 may be a computer monitor or an LCD screen, or any other device capable of displaying the output of computer 156.

Specification at paragraph [0026] (emphasis added). Thus, the Specification describes that a web phone may be the computing device on which the electronic programming guide is displayed. In addition, paragraph [0030] of the Specification, which was previously amended to incorporate subject matter from U.S. Patent Application Serial No. 09/488,361, states:

Input device 160 can be used to select programs to be watched on video display 105, or to otherwise browse through the EPG. In addition, a cable television provider sending programming to set top box 110 may have preset selections to send to computing device 150. A user may also use input device 160 to make viewing selections, preprogram reminders for viewing selections, program recording events, or perform any other functions typical of Electronic

Programming Guides (EPGs). An EPG in accordance with one embodiment of the invention can include several features that enhance user friendliness. For example, in one embodiment, the EPG; provides an indication of which buttons on the input device can be actuated in a given situation. In another embodiment, the various control buttons of the input device contain or are associated with LEDs or other indicators (e.g. liquid crystal displays (LCDs) in conjunction with a touch screen etc.). The LEDs corresponding to those buttons that can be pressed in a given situation illuminate, thereby informing the viewer which buttons he or she can press in a given situation. In yet another embodiment, the EPG may include a window on the screen (not shown) that indicates to the user which buttons would be appropriate to actuate in a certain situation. In yet another embodiment, the EPG displays user assistance information on the screen if the user tries to actuate an inappropriate button on the input device. By indicating to the user which keys can be pressed in a given situation, user friendliness of an EPG in accordance with the invention is enhanced.

Specification at paragraph [0030]. Thus, the Specification describes an electronic programming guide that may include an indication of which buttons on an input device would be appropriate to actuate in a certain situation. In addition, the Specification further states:

A wireless hand held device, such as hand held unit 220 allows for a great deal of flexibility. A user may move about the room which contains video display 105 and be able to control the functions of the EPG from any point. When using a wireless hand held device to control the EPG, the device may also assume the functions of remote control device 120.

Specification at paragraph [0036] (emphasis added). Thus, the Specification describes using a wireless hand held device to remotely control a video display and an electronic programming guide. Furthermore, despite the Office Action's assertion, at page 4, that "the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG," Applicant notes that the Specification also states:

FIG. 3 illustrates a system 105 and a number of wireless hand-held devices. In one embodiment, hand held units 310a-n can display an EPG for entertainment system 100 on their screens. However, hand-held units 310a-n are capable of communicating either with STB 205 through antennae 315a-n or with STB 205 through network 125. Hand held devices 310a-n may communicate with network 125 via multiple techniques, including but not limited to cellular, PCM, satellite, Blue-Tooth.TM., etc. In one embodiment, the handheld

units would communicate with the satellite 235 or other alternative features.

Specification at paragraph [0038] (emphasis added). Thus, the Specification describes hand-held devices with cellular capabilities, such as web phones, displaying an electronic programming guide on their display screens.

Moreover, with respect to the Office Action's assertion that claims 6-7 and 14-15 do not comply with the written description requirement, *see* Office Action at page 5, Applicant respectfully notes that the Specification states:

FIG. 3 illustrates a system 105 and a number of wireless hand-held devices. In one embodiment, hand held units 310a-n can display an EPG for entertainment system 100 on their screens. However, hand-held units 310a-n are capable of communicating either with STB 205 through antennae 315a-n or with STB 205 through network 125. Hand held devices 310a-n may communicate with network 125 via multiple techniques, including but not limited to cellular, PCM, satellite, Blue-Tooth.TM., etc. In one embodiment, the handheld units would communicate with the satellite [*sic*] 235 or other alternative features.

Specification at paragraph [0038] (emphasis added). Thus, the Specification describes the hand-held devices with cellular capabilities, such as web phones, communicating with a network 125 that may include other hand-held devices.

In sum, Applicant respectfully submits that the above-quoted passages of the Specification, in addition to the Specification and Figures of the instant application in their entireties, provide support for the current pending claims. Thus, Applicant respectfully submits that claims 1-3, 6-11, 14-16, and 27-30 satisfy the written description requirement and respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3, 9-11, 28 and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2005/0028208 of Ellis et al. ("Ellis '208") in view of U.S. Patent No. 6,774,926 to Ellis et al. ("Ellis '926") in further view of U.S. Patent No. 5,936,611 to Yoshida ("Yoshida") in further view of U.S. Patent No. 6,745,223 to Nobakht et al. ("Nobakht"). Claims 6, 7, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ellis '208 in view of Ellis '926 in further view of Yoshida in

further view of Nobakht in further view of U.S. Patent No. 6,754,904 to Cooper et al. (“Cooper”). Claims 8 and 16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ellis ‘208 in view of Ellis ‘926 in further view of Yoshida in further view of Nobakht in further view of U.S. Patent No. 6,246,441 to Terakado et al. (“Terakado”). Claims 27 and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ellis ‘208 in view of Ellis ‘926 in further view of Yoshida in further view of Nobakht in further view of U.S. Patent No. 6,853,308 to Dustin (“Dustin”). For the reasons set forth below, Applicant respectfully traverses these rejections.

Independent claim 1 recites, *inter alia*, “indicating on the first web phone, based on the displayed electronic programming guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide.” Applicant respectfully submits that Ellis ‘208, Ellis ‘926, Yoshida, and Nobakht, whether applied alone or in combination, fail to teach or suggest such features.

The Office Action concedes that Ellis ‘208 and Ellis ‘926 “are silent as to the EPG including an indication of which web-enabled cellular phone buttons are appropriate for the EPG. While Ellis (‘926 Patent) teaches the use of a web-enabled cellular phone to make EPG selections, neither Ellis reference teaches indicating to the user which buttons can be used for a particular set of functions.” Office Action at 6. However, the Office Action asserts:

Yoshida discloses an EPG that displays an image of the remote control the viewer is using (see Figure 7). The remote control image on the display further provides an indication to the user each key’s functionality when a user presses the key on the remote control (see Figures 7-9 and Column 6, Line 30 through Column 8, Line 29). Further note that the Yoshida reference discloses displaying a help screen that indicates which buttons a remote control device that are appropriate for performing functions for the EPG (see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG). Therefore Yoshida teaches indicating on a remote control, based on the displayed electronic programming guide, that at least one button of the remote control is appropriate for performing an action associated with the electronic programming guide.

Office Action at 6-7 (emphasis added). Applicant respectfully disagrees. In pertinent part, Yoshida states:

According to the present invention, when a predetermined key, for example, the MENU key (or HELP key which is not shown in FIG.

2) on the remote control hand unit 10 is pressed, the mode is changed over to the help mode and the remote control hand unit body 10 and its keypad are graphically displayed on the screen (the display screen) of the CRT 9 by performing the predetermined operation. When the user presses a key on the remote control hand unit 10, the corresponding key displayed graphically on the display screen blinks or changes in color. At the same time, the functional description (the main points of the functional description described in the manual) of the key is displayed on the display screen.

Yoshida at 4:52-64 (emphasis added). While Yoshida thus describes a user pressing a key on the remote control hand unit and a functional description of the key being displayed on the remotely controlled display screen, Yoshida lacks any teaching or suggestion of “indicating on the first web phone, based on the displayed electronic programming guide, that at least one button of the first web phone is appropriate for performing an action associated with the electronic programming guide,” as recited in claim 1.

Indeed, even assuming, without conceding, that Yoshida’s displaying of a functional description corresponding to a particular key of the remote control hand unit 10 may be properly equated with indicating that at least one button is appropriate for performing an action, as recited in claim 1, the functional description described in Yoshida is nevertheless displayed on a display screen (i.e., CRT 9) that is different from the device which received the selection of the key (i.e., remote control hand unit 10). By contrast, in claim 1, not only is the recited indicating “on the first web phone,” but the selection associated with the electronic programming guide also is received “at the first web phone.”

Moreover, Nobakht, which was cited for its alleged description of “remote control 130-C contains a display screen and can be a web phone (see Figure 1 and Column 17, Lines 9-14),” *see* Office Action at page 7, fails to cure the above-discussed deficiencies of Ellis ‘208, Ellis ‘926, and Yoshida with respect to claim 1. Rather, Nobakht generally describes associating channel numbers with Internet addresses (e.g., URLs) so as to allow users to access internet sites using such channel numbers. *See e.g.* Nobakht at col. 2, lines 2-18.

Thus, even assuming, without conceding, that Ellis ‘208, Ellis ‘926, Yoshida, and Nobakht would have been properly combinable, no combination thereof would have resulted in the features of claim 1. For at least these reasons, independent claim 1 is distinguishable over Ellis ‘208, Ellis ‘926, Yoshida, and Nobakht.

In addition, independent claim 9 recites features similar to those discussed above with respect to claim 1. Thus, claim 9 is distinguishable over Ellis '208, Ellis '926, Yoshida, and Nobakht for substantially the same reasons as claim 1.

Claims 2, 3, 10, 11, 28 and 30 ultimately depend from one of independent claims 1 and 9, and therefore are distinguishable over Ellis '208, Ellis '926, Yoshida, and Nobakht by virtue of their dependence and further in view of the various features recited therein.

Furthermore, claims 6-8, 14-16, 27, and 29, which likewise ultimately depend from one of independent claims 1 and 9, have been rejected over the same combination of Ellis '208, Ellis '926, Yoshida, and Nobakht applied to claim 1, further in view of Cooper, Terakado, or Dustin. However, Cooper, Terakado, and Dustin, which were cited for their alleged description of other features of these dependent claims, fail to cure the above-discussed deficiencies of Ellis '208, Ellis '926, Yoshida, and Nobakht with respect to claim 1. Thus, claims 6-8, 14-16, 27, and 29 are distinguishable by virtue of their dependence and further in view of the various features recited therein.

[SIGNATURE PAGE FOLLOWS]

CONCLUSION

All issues having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or if there are any questions, the Examiner is invited to contact the undersigned at (202) 824-3161.

Respectfully submitted,
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Dated: July 21, 2011

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